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Supreme Court of the United States

October Term, 1975

No. 75-489

LAWRENCE R. SPERBERG,

Petitioner,

vs.

THE GOODYEAR TIRE & RUBBER COMPANY, THE FIRESTONE TIRE & RUBBER COMPANY, THE GENERAL TIRE & RUBBER COMPANY and B. F. GOODRICH COMPANY,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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I.

Introductory Statement.

Respondent, The Goodyear Tire & Rubber Company, respectfully submits this brief in opposition to the Petition of Lawrence R. Sperberg for writ of certiorari to the United States Court of Appeals for the Sixth Circuit.

II.

Counterstatement of the Case.

This is a patent case resulting from four actions brought by petitioner alleging infringement of two patents by the four respondents herein. In the interest of judicial econ-

omy, by stipulation of the petitioner and all respondents, approved by the District Court and adopted by the Court of Appeals, the case was tried between petitioner, Lawrence R. Sperberg (hereinafter "Sperberg"), and one respondent, The Goodyear Tire & Rubber Company (hereinafter "Goodyear"), the petitioner and the remaining respondents agreeing to be bound by the result of that trial.*

The *Goodyear* case was tried before a jury of six which Sperberg had demanded. The trial lasted three and one half weeks and resulted in a general verdict in favor of Goodyear supported by the jury's answers to twenty interrogatories (F.R. Civ. P. 49(b)) finding both patents not infringed, and invalid on three separate grounds.

On appeal, Sperberg did not challenge the jury's resolution of the validity and infringement issues, but instead attacked the trial court's procedural handling of the trial. The appellate court found the trial court's conduct of the trial to be proper in all respects and unanimously affirmed the judgment which had been entered on the jury's verdict.

At both the trial and on the appeal, Sperberg alleged that the trial court had not given complete and accurate instructions to the jury concerning the statutory presumption of patent validity, 35 U.S.C. § 282. This contention was soundly rejected by both courts below. Sperberg now comes to this Court seeking a third consideration of this issue, which is an issue not havng any significance beyond the private interests of the parties herein and which, in any event, is totally devoid of merit.

* The remaining respondents are The Firestone Tire & Rubber Company which agreed to be bound by the decision in the *Goodyear* case as to both validity and infringement, and The General Tire Company and the B. F. Goodrich Company which agreed to be bound as to validity, reserving the right to separate trials on the issue of infringement. Since the patents were held invalid, such separate trials did not become necessary.

III.

Argument.

A. There Is No Merit In The Issue Presented By Sperberg

Sperberg's contention is that both courts below did not give proper consideration to the statutory presumption of validity, 35 U.S.C. § 282, in relation to instructing the jury concerning the respective parties' burden of proof.

The fallacy of Sperberg's position becomes apparent when one considers that the trial court went out of its way to instruct the jury concerning the presumption of validity, and if anything, gave Sperberg more than he was entitled to in instructing on the presumption.* The trial court instructed the jury as follows:

> "Presumptions are deductions or conclusions which the law requires the Jury to make under certain circumstances in the absence of evidence in the case which leads the jury to a different or contrary conclusion. A presumption continues to exist only so long as it is not overcome or outweighed by evidence in the case to the contrary; but unless and until so outweighed, the Jury should find in accordance with the presumption.
>
> "The burden of proof of the affirmative defenses directed to the invalidity of the patents herein hav-

* There is a substantial body of opinion which holds that presumptions should not be mentioned to a jury at all. See, e.g., American Law Institute Model Code of Evidence, Rule 704, Comment (b) on paragraph 2, which states:

> "A presumption, to be an efficient legal tool, must (1) be left in the hands of the judge to administer, and not be submitted to a jury for decision of the question when it is 'rebutted' or ceases to have compelling force; (2) *be so administered that the jury never hear the word presumption used since it carries unpredictable connotations to different minds;* * * *," (Emphasis added).

ing been asserted by the defendant places the burden of proof as to one or more of these assertions upon the defendant by clear and convincing evidence.

> *"In considering the defenses of invalidity, the court instructs you that the law presumes the patents here in question to be valid, in the absence of clear and convincing evidence to the contrary; presumes further that the Patent Office acted correctly in issuing the patents.*
>
> *"This presumption of validity continues in effect in favor of the plaintiff unless there is clear and convincing evidence which leads the Jury to a different or contrary conclusion."* (App. Vol. 6, pp. 1295-96).* (Emphasis added).

The trial court then instructed the jury concerning Goodyear's defenses, and in the course of those instructions, informed the jury *thirteen times* that Goodyear had the burden of proving the patents invalid by evidence which was clear and convincing.

Sperberg maintains that this was not enough and that an additional instruction should have been given to the effect that any burden Sperberg bore as to validity was *carried* by the statutory presumption of validity.

The Court of Appeals rejected Sperberg's contention, recognizing that such an instruction was not only unnecessary but would have improperly given the presumption of validity independent evidentiary value. The Court of Appeals stated:

> "The plaintiff argues that these instructions are correct as far as they go, but that the court 'should have instructed the jury that the issuance of the patent was cogent evidence from which a presumption arises, that, by itself, carries Sperberg's burden

* App. refers to the joint appendix in the Court of Appeals.

of proof as to validity in the absence of clear and convincing evidence to the contrary.'

> "We have read the court's entire charge to the jury and believe it correctly presented the issues with respect to validity of the patents. There is no reason to believe that the jury was in any way confused as to the burden of proof in this case. The fact is that the plaintiff had the burden of proving the validity of his patent. The issuance of letters by the Patent Office, because of the statutory presumption of validity, makes a *prima facie* case for a plaintiff asserting the validity of his patent. This presumption has no independent evidentiary value, however, but only serves to place the burden of proof on a party who asserts invalidity. *Rains* v. *Niaqua, Inc.* 406 F.2d 275, 278 (2 Cir. 1969). As the Supreme Court pointed out in *Del Vecchio* v. *Bowers,* 296 U.S. 280 (1935), a statutory presumption 'falls out of a case' when the party against whom the presumption works meets his burden of offering evidence sufficient to justify a contrary finding. *Id.* at 286. *We find no basis for believing that the jury in this case understood the instructions on validity to mean anything other than that the plaintiff entered the case with a presumption that both patents were valid and that the jury could only find them invalid if the defendant introduced clear and convincing evidence of invalidity."* (Court of Appeals Decision, p. 9). (Emphasis added).

Thus, with clear and unequivocal instructions in mind, the jury returned a general verdict for Goodyear and answered twenty interrogatories which were consistent with and supportive of the general verdict. The jury found both patents invalid on three separate grounds, and also found, quite apart from validity, or the presumption thereof, that neither patent had been infringed by Goodyear. It is apparent that Sperberg's assertion to this Court that the jury was

confused is totally baseless, and, in any event, certainly does not raise a question worthy of consideration by this Court.

B. The Issue Raised By The Petition Does Not Merit Review By This Court.

Rule 19 of this Court declares that, "A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor." As stated by Chief Justice Vinson in his often quoted address before the American Bar Association on September 7, 1949:

> "The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower court decisions. In almost all cases within the Court's appellate jurisdiction, the petitioner has already received one appellate review of his case . . .
>
> "The function of the Supreme Court is, therefore, to resolve conflicts of opinion on federal questions that have arisen among lower courts, to pass upon questions of wide import under the Constitution, laws and treaties of the United States, and to exercise supervisory power over lower federal courts . . .
>
> "To remain effective the Supreme Court must continue to decide only those cases which present questions whose resolution will have immediate importance far beyond the particular facts and parties involved." 69 S. Ct. v.

This Court succinctly summarized the limits of certiorari review and the general propensity of those seeking review to fail to appreciate those limits in *Magnum Import Co.* v. *Coty,* 262 U.S. 159, 163 (1923), which states:

> "The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes, first to secure uniformity of decision between

> those courts in the nine circuits, and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this Court of last resort. The jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing. Our experience shows that eighty per cent. (sic) of those who petition for certiorari do not appreciate these necessary limitations upon our issue of the writ."

Applying these principles, which are of even greater urgency for the overcrowded dockets of 1975 than they were in 1923 or 1949, to the present case, it is apparent that the issue presented by the petition does not raise any question of public importance, does not conflict with the decisions of this or any other court but is simply an attempt by Sperberg:

> ". . . . to give the defeated party in the Circuit Court of Appeals another hearing." *Id.*

It is difficult to conceive how instructions to a jury in an ordinary patent case dealing with a matter as routine and well-established as the statutory presumption of validity can be considered as an issue of great public importance. Most patent cases are not even tried before a jury and, thus, the issue raised by petitioner has even less general application than the host of other patent issues which are presented to this Court.

IV.

Conclusion.

The question proposed as meriting review, specifically, the effect of the statutory presumption of validity, is a question that has been fully answered by existing authority.

Application to the specific situation of this case does not present any new question and the issues here have been correctly determined by the Court of Appeals following the cited precedents. Since no special and important reasons and no substantial questions meriting review under Supreme Court Rule 19 have been presented, this petition should be denied.

Respectfully submitted,

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